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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,486	08/05/2003	Stephane Schinazi	1264-03	7037

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IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP
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EXAMINER

HSU, ALPUS

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 05/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/634,486	Applicant(s) SCHINAZI, STEPHANE	
	Examiner Alpus H. Hsu	Art Unit 2616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 August 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>10/16/03</u> . | 6) <input type="checkbox"/> Other: ____ |

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1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means in apparatus claims and/or the steps in method claims, all must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

2. The following is a quotation of the first paragraph of 35 U.S.C. § 112:
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to provide an enabling disclosure.

The disclosure does not provide enough structural detail to enable an artisan to make and use the invention without undue experimentation.

The Court of Customs and Patent Appeals has held that, a disclosure which gives only a block diagram and a broad description of the functions of those blocks without disclosing the specific structure of the blocks or explaining the interconnection, timing and control of the various components is *prima facie* not enabling. *In re Gunn*, 190 U.S.P.Q. 402 (CCPA 1976). A conclusion of nonenablement is rebuttable, but the burden is upon applicant to come forward with evidence of enablement with regards to the specific invention claimed. *Id.* at 405.

The drawings in this case are a series of block diagram. The detailed description does not specify any structure for the various blocks or explain how the components connect to each other and interact with each other to perform the functions claimed.

The specification answers none of these questions. Absent answers or evidence showing that an artisan would have known the answers without resort to undue experimentation, the disclosure is *prima facie* non-enabling under the rationale set forth in *Gunn supra*.

To comply with the enablement clause of the first paragraph of 35 U.S.C. § 112, the disclosure must adequately describe the claimed invention so that the artisan could practice it without undue experimentation. *In re Scarbrough*, 500 F.2d 560, 182 U.S.P.Q. 298 (CCPA 1974); *In re Brandstadter*, 484 F.2d 1395, 179 U.S.P.Q. 286 (CCPA 1973); *In re Gay*, 309 F.2d 769, 135 U.S.P.Q. 311 (CCPA 1962). If the Examiner has a reasonable basis for questioning the sufficiency of the disclosure, the burden of proof shifts to applicant to come forward with evidence to rebut this challenge. *In re Doyle*, 482 F.2d 1385, 179 U.S.P.Q. 227 (CCPA 1973); *In re Brown*, 477 F.2d 946, 177 U.S.P.Q. 691 (CCPA 1973); *In re Ghiron*, 442 F.2d 985, 169 U.S.P.Q. 723 (CCPA 1971).

Applying this case law to the facts of this case, as discussed above the examiner believes that he has made out a reasonable prima facie case that the instant disclosure is not enabling. Thus the burden is on applicant to come forward with evidence showing enablement.

3. Claims 1-22 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection to the specification.

4. Claims 1-10, 14, 15, 19-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-10, 19-22, all claims are rejected as indefinite for being hybrid claims since each claim includes method steps for the method claim and means for the apparatus claim, which render each claim indefinite since it is unclear and ambiguous as to whether a method or an apparatus is intended for the claim.

Furthermore, claims 7-10 are also rejected as being indefinite since all claims are directed to be a device which depend on claim 1 which is a method claim, and therefore render all claims being indefinite since it is unclear as to what portion in the method claim is intended to be included in claims 7-10 as the claim limitation.

In addition, regarding claim 14, the phrase "(e.g., the Caller ID or the telephone number)" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

5. Due to the nature of 112, first and second paragraph problems as indicated above, there is no prior art rejection can be applied or allowable subject matter can be determined at this time.

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6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

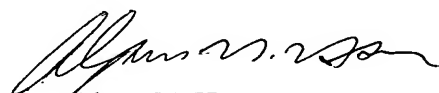
Bonnaure et al., Bleuse et al., Martin, Jr. Et al. and Keller are cited to show the feature of client access to the Internet via access network and Internet service provider server similar to the claimed invention.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alpus H. Hsu whose telephone number is (571)272-3146. The examiner can normally be reached on M-F (5:30-3:00) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on (571)272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AHH



Alpus H. Hsu
Primary Examiner
Art Unit 2616